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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,365	10/09/2002	Robert W. Bassett	BUR920010209	7874

24241 7590 06/30/2005
IBM MICROELECTRONICS
INTELLECTUAL PROPERTY LAW
1000 RIVER STREET
972 E
ESSEX JUNCTION, VT 05452

EXAMINER

BRITT, CYNTHIA H

ART UNIT	PAPER NUMBER
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2133

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/065,365

Applicant(s)

BASSETT ET AL.

Examiner

Cynthia Britt

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 June 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see response to amendment on separate page. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-10.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.


**GUY LAMARRE
PRIMARY EXAMINER**

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Response to Amendments

Claim 1 as amended recites, "custom test control logic is not required to perform parametric testing". Although it is appropriate to include negative limitations in the claims, new matter is not permitted. The present invention should be claimed on the basis of the merits of the disclosure of the invention and additional negative limitations should not be necessary to claim the function or the merits of the invention. Applicant is requested to carefully review all amendments included in this response to verify no additional new matter is added.

On page 5 paragraph 3 lines 7-9, of the amendment after final, applicant states *"Conversely, Applicants' invention does not require the custom design of logic controls that are specific to each design and is therefore not suggested or motivated by Ellison. (Applicants' Spec. Paragraphs 57, 58)"* These paragraphs are quoted below.

[0057] The designer will continue to design the product, run test generation, and submit the external I/O test patterns without knowledge of the banking configuration that will later be determined by manufacturing. Each test in the test patterns may contain any number of stimuli and measures on the external I/O pins. As provided by the customer, the external I/O test patterns obtain high parametric fault coverage and require a full pin count tester.

[0058] Attention is directed to FIG. 1, which shows the process steps used in the present invention. The first process described below analyzes an ASIC product's physical design data, logical test data, and module description. It recognizes the presence of differential I/O, voltage reference I/O and any other types of I/O that have special banking restrictions. The banking constraints required for these exceptional types of I/O pins is defined to the process by a set of rules. Rules can also be included which define guidelines that allow design/build optimization and reuse of module test fixtures or the programming of the channel assignments within the intermediate banking box. For a high pin count ASIC, this process generates a list of allowable

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banking configurations for the product. Multiple "banking" configurations are possible for each ASIC. With this flexibility, two or more ASIC products can be "banked" in the same configuration. The most general "banked" configuration for ASICs with a common physical image can be used allowing multiple products to share the banking configuration and hardware.

There is no mention of using or not using custom test control logic.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Britt whose telephone number is 571-272-3815. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on 571-272-3819. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Cynthia Britt
Examiner
Art Unit 2133


GUY LAMARRE
PRIMARY EXAMINER